Hearing: May 18, 2004 — Mailed: September 30, 2004 PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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H-D Michigan, Inc.
v.
Boutique Unisexe El Baraka, Inc. and 3222381 Canada, Inc., joined as a party defendant

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Opposition No. 91108265 and
Cancellation Nos. 92027073 and 92029665

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Kristin L. Murphy and Michael A. Lisi of Rader, Fishman & Grauer PLLC and Linda K. McLeod and David M. Kelly of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. for H-D Michigan, Inc.

Janet F. Satterthwaite of Venable, LLP for Boutique Unisexe El Baraka, Inc. and 3222381 Canada, Inc.

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Before Simms, Hairston and Walters, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The above captioned opposition and cancellation proceedings were consolidated by order of the Board dated July 26, 2000. H-D Michigan, Inc. is the opposer and the petitioner in the respective cases, and in this decision will be referred to as plaintiff. Boutique Unisexe El

Baraka, Inc. (a Canadian corporation) is the applicant and respondent in the respective proceedings, and will be referred to as Boutique. 3222381 Canada Inc. (also a Canadian corporation) has been joined as party defendant in the cancellations by virtue of an assignment from Boutique of the involved registrations, and it will be referred to as 3222381. Because the opposition and cancellations involve the same parties and common questions of law and fact, we shall decide the three cases in this single opinion.

In the application involved in the opposition, Boutique seeks registration on the Principal Register of the mark SCREAMING EAGLE (in typed form) for the following goods: "jewelry, namely pendant[s]; ear-rings, bracelets, rings, brooches" in class 14; "posters" in class 16; "wallets, handbags, satchel[s], cyclist bags, key cases" in class 18; "beer mugs" in class 21; and "clothing for men, women and children, namely undershirts, shorts, swimsuits, dresses, skirts, pajamas, caps, scarfs (sic), head-bands; crest; leather clothing, namely skirts, coats, caps[;] eye-shades; [and] jeans" in class 25.[1]

[1] Application Serial No. 74574289, filed September 16, 1994, asserting a bona fide intention to use the mark in commerce.

The registrations of Boutique involved in the cancellations are of the marks SCREAMING EAGLE for "coffee mugs" in class 21 and "clothing for men, women and children, namely T-shirts, belts, sweat-shirts, pants; [and] leather clothing, namely jackets in class 25""[2] and SCREAMIN' EAGLE for "wallets, handbags, satchels, cyclist bags, key cases, purses" in class 18; "clothing for men, women and children, namely belts, sweatshirts, pants, jeans, camisoles, shorts, bathing suits, dresses, skirts, pajamas, caps, hats, visors, scarves, head-bands, wristbands; leather clothing, namely skirts, jackets, coats, pants, gloves and boots" in class 25; and "belt buckles not of precious metal; brooches not of precious metal" in class 26.[3]

Plaintiff filed an amended notice of opposition to Boutique's application and an amended petition to cancel each of Boutique's registrations, asserting in all three cases a Section 2(d) claim of priority and likelihood confusion; and a claim that Boutique committed fraud in the filing of its pending application and the applications that matured into the involved registrations. Additionally, in

[2] Registration No. 1,886,489 issued on March 28, 1995 from an application filed on August 20, 1992, which alleged a bona fide intention to use the mark in commerce. This registration was cancelled June 18, 2003 under the provisions of Section 8 of the Trademark Act. This registration is the subject of Cancellation No. 92027073.

[3] Registration No. 2,188,686 issued on September 15, 1998 from an application filed on April 18, 1995, which was based upon Section 44(e) of the Trademark Act. This registration is the subject of Cancellation No. 92029665.

the cancellations, plaintiff asserted a claim of abandonment.

Specifically, plaintiff alleged that it is a subsidiary/licensee of Harley-Davidson Motor Company (hereinafter Harley-Davidson); that Harley-Davidson first used the mark SCREAMIN' EAGLE on or in connection with motorcycle parts and accessories at least as early as 1983, jewelry products and belt buckles at least as early as 1985, and decals, lighters, and clothing at least as early as 1987; that each of Boutique's marks, as applied to the goods identified in Boutique's application and registrations, so resembles plaintiff's mark SCREAMIN' EAGLE as to be likely to cause confusion, to cause mistake or to deceive. Plaintiff pleaded ownership of Registration No. 1,345,492 for the mark SCREAMIN' EAGLE for various motorcycle parts and accessories.[4]

Further, plaintiff alleged that Boutique "has been aware of Harley-Davidson's use of the mark SCREAMIN' EAGLE since at least 1992 or early 1993"; and Boutique's "execution [of each of its applications] was an act of fraud." Additionally, in the cancellations, plaintiff alleged that Boutique has not used the marks that are the

[4] Issued on July 2, 1985 from an application filed on November 11, 1983 which sets forth dates of first use of September 14, 1983; Sections 8 and 15 affidavits accepted and acknowledged, respectively.

subject of the involved registrations and thus Boutique has abandoned the marks.

Boutique answered the amended notice of opposition and each amended petition for cancellation by admitting that it knew of Harley-Davidson in 1992 or 1993 but otherwise denying the salient allegations therein.

Before turning to the record and merits of the case, we must discuss a preliminary matter. As previously noted, Boutique's Registration No. 1,866,489 (the subject of Cancellation No. 92027073) was cancelled June 18, 2003 under the provisions of Section 8 of the Trademark Act. In accordance with Trademark Rule 2.134, the Board allowed Boutique time to show cause why judgment should not be entered against it. Boutique responded, stating it did not permit its registration to be cancelled, but rather the Patent and Trademark Office rejected its declaration of excusable nonuse. Boutique stated that it was considering an appeal and requested that judgment not be entered against it. Plaintiff filed a paper "opposing" Boutique's response wherein it argued that Boutique had failed to show cause why judgment should not be entered against it. Plaintiff requested that the Board enter judgment against Boutique on the abandonment claim and proceed to trial on the likelihood of confusion and fraud claims. The Board found Boutique's showing to be sufficient to set aside the show cause order

and proceedings were thereafter resumed. Boutique, at page 22, n. 95, of its brief on the case contends that the issues in Cancellation No. 92027073 are moot as the result of the cancellation of Registration No. 1,886,489 under Section 8. In particular, Boutique states that "the Board should not, and need not, decide whether there is a likelihood of confusion, or fraud on the Trademark Office, with respect to the goods set forth in Reg. No. 1,886,489. Therefore, the Board must enter judgment in [Cancellation No. 92027073] on the sole ground of non-use under Section 8." (emphasis in original).

Inasmuch as the Board set aside the show cause order and resumed proceedings in the cancellation, Boutique's contention is not well taken. Moreover, we note that plaintiff, in its brief on the case, renewed its request that the Board decide its likelihood of confusion and fraud claims pointing out that Boutique's assignee, 3222381, has filed two additional applications to register the marks SCREAMING EAGLE and SCREAMIN' EAGLE for various goods, some of which are identical to those in the involved application and registrations.

Under the circumstances, the petition to cancel Registration No. 1,886,489 on the ground of nonuse is granted to the extent that judgment is hereby entered against Boutique on this ground. The Board will decide the

petition to cancel the registration with respect to the issues of likelihood of confusion and fraud.

The record consists of the pleadings, and the files of the involved application and registrations. Plaintiff submitted the testimony depositions (with exhibits) of the following individuals: John Troll, former vice-president and trademark counsel for plaintiff H-D Michigan, Inc.; Thomas Bolfert, Director of Corporate Archives for Harley-Davidson Motor Company; Douglas Decent, marketing director of Fred Deeley Imports of Canada; Jamal Berrada, president of Boutique and 3222381; Anne Paluso; marketing manager for parts and accessories at Harley-Davidson Motor Company; and John Henslee, trademark manager for Harley Davidson Motor Company. During the testimony deposition of its witness Mr. Troll, plaintiff introduced a certified copy of its pleaded Registration No. 1,345,492 for the mark SCREAMIN' EAGLE for motorcycle parts and accessories.[5] In addition, plaintiff submitted by notice of reliance the following materials: copies of 3222381's applications Serial Nos. 76266302 and 76266303 for the marks SCREAMIN' EAGLE and SCREAMING EAGLE

[5] We note that plaintiff also introduced a certified copy of its Registration No. 1,953,342 for the mark SCREAMIN' EAGLE CHILI for "chili," which issued January 30, 1996; Sections 8 and 15 affidavits accepted and acknowledged, respectively. Although Boutique did not object to plaintiff's introduction of this unpleaded registration and thus the pleadings may be deemed amended to plead ownership of the registration, see Fed. R. Civ. P. 15(b), plaintiff has not relied on this registration in connection with any of its claims in these proceedings. Thus, we have given no consideration to the registration.

respectively for clothing and accessories; Boutique's answers to plaintiff's interrogatories; Boutiques responses to plaintiff's requests for admission; the discovery depositions (with exhibits) of Mr. Berrada; Rebecca Stratman, president of Global Products; Tammy Stratman, president of RK Stratman; and David Woodruff, vice-president of sales and marketing for Sport Service.

Boutique's evidence consists of the testimony depositions (with exhibits) of Mr. Berrada and Ruth Dillon, a paralegal at the office of Boutique's counsel; and a notice of reliance on copies of ten third-party registrations for marks containing SCREAMING/SCREAMIN and EAGLE. These consolidated cases have been fully briefed and an oral hearing was held before the Board.

Priority

As noted, plaintiff made a certified copy of its pleaded registration of record for the mark SCREAMIN' EAGLE for motorcycle parts and accessories. Thus, for the purpose of the opposition proceeding, priority is not an issue with respect to the goods identified in this registration. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc. 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, priority lies in favor of plaintiff in the cancellation proceedings with respect to motorcycle parts and accessories. The certified copy of plaintiff's registration for such goods shows that

the filing date of the application which matured into this registration is earlier than the filing dates of the applications which matured into Boutique's involved registrations. See, e.g., Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1428-29 (TTAB 1993) at n. 13. Further, plaintiff has proven, and Boutique does not dispute that Harley-Davidson first used the SCREAMIN' EAGLE mark in commerce on motorcycle parts and accessories in 1983.[6] Such use also predates the filing dates of the applications which matured into Boutique's involved registrations.[7]

The issue therefore is whether in the opposition and cancellation proceedings plaintiff has priority of SCREAMIN' EAGLE for collateral goods, namely, jewelry, belt buckles, emblems/patches, lighters, caps and T-shirts.

Plaintiff maintains that Harley-Davidson expanded use of the SCREAMIN' EAGLE mark to collateral products, namely belt buckles and pins in 1985, and baseball caps, lighters, T-shirts and emblems/patches in 1987; and that Harley-

[6] Indeed, Boutique states: "Harley initiated a line of performance parts for motorcycles which it called SCREAMIN' EAGLE in 1983." (Brief, p. 1).

[7] In these proceedings, Boutique did not present evidence of use which predates the filing dates of its pending application or the applications which matured into the involved registrations. Thus, the earliest use dates on which Boutique may rely for priority purposes is the application filing dates. Levi Strauss Co. v. R. Josephs Sportswear, 28 USPQ 1464 ((TTAB 1993), recon. denied, 36 USPQ2d 1328 (TTAB 1994). We note the following statement at page 22 of Boutique's brief: "Boutique is entitled to rely on the filing dates of its applications."

Davidson's use of the SCREAMIN' EAGLE mark on these collateral products "continued throughout the 1980's, 1990's and today." Brief, p. 9.

Boutique, on the other hand, argues that Harley-Davidson has not established use of SCREAMIN' EAGLE in a trademark manner on these collateral goods prior to the filing dates of Boutique's pending application and the applications which matured into the involved registrations. Boutique contends that Harley-Davidson has not used SCREAMIN' EAGLE per se on its collateral goods, but rather the composite logos HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design as shown below;

and that Harley-Davidson has not furnished documentary evidence of sales of collateral goods bearing SCREAMIN'

EAGLE per se. Further, Boutique argues that to the extent that plaintiff/Harley-Davidson had any trademark rights in the composite logos or SCREAMIN' EAGLE per se, such rights were abandoned as a result of Harley-Davidson's failure to use the logos between 1994 and 1997. Boutique also argues that Harley-Davidson's use of the composite logos on collateral products is ornamental and does not serve to create any trademark rights in the composite logos or SCREAMIN' EAGLE per se, and that "[e]ven if [each of the composite] logo[s] does have trademark significance to at least some consumers, it functions at best only as a secondary indicator of source." Brief, p. 21. According to Boutique, because the collateral goods are in the nature of promotional items for Harley-Davidson's motorcycle parts and accessories, use of the composite logos on collateral goods does not permit plaintiff to block registration of another allegedly similar mark.

Plaintiff H-D Michigan, Inc. is an intellectual property company that owns and manages the trademarks used by Harley-Davidson. Troll test. dep. p. 11. Harley-Davidson has sold Harley-Davidson brand motorcycles and motorcycle parts and accessories for over 100 years. For many decades, Harley-Davidson has sold, under the Harley-Davidson brand, collateral goods such as clothing, belts, helmets, footwear, sunglasses, collectible items, watches,

lighters, key chains, coffee mugs and jewelry. Troll test. dep. pp. 13 and 81-82. Mr. Troll [test. dep. p. 19] explained that there are two ways in which Harley-Davidson arranges for the sale of its Harley-Davidson brand collateral goods:

> There is a group within the company that, who is – that is devoted to developing products for sale in the dealership, and there is a kind of parallel organization with some overlap that develops products for sale either also at the dealership or outside the dealer network in mass market retail channels, other than motorcycle dealerships. That—that's the licensing group. The merchandising group is more devoted to intern—-to Harley-Davidson motorcycle shops. The licensing group, although many of our licensees also sell to our dealerships, many of our licensees sell to the mass market.

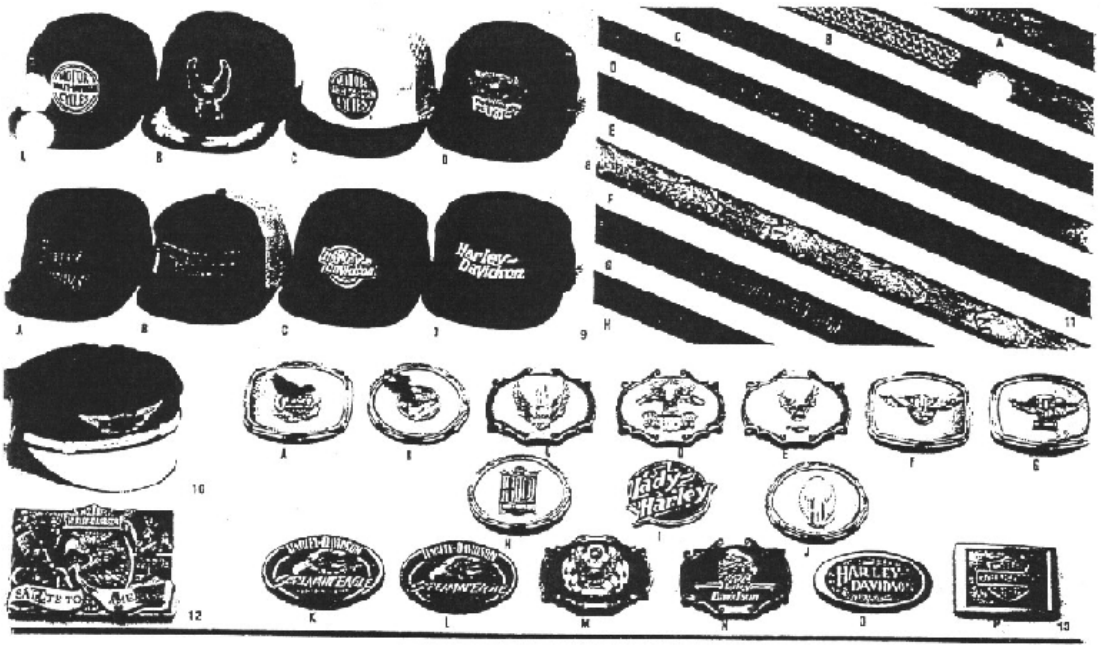
Harley-Davidson sells its Harley-Davidson brand collateral goods through an e-commerce Internet website, in Harley-Davidson dealerships, at retailers such as Wal-Mart, Bloomingdale's, Hallmark, through Franklin Mint and specialty merchants such as Sport Service, the licensing agent of the National Hot Rod Association. Troll test. dep. p. 51.

Harley-Davidson advertises its Harley-Davidson brand motorcycles, parts and accessories, and collateral goods on television, in magazines and in its own catalogs. Paluso test. dep. p. 8; Bolfert test. dep. pp. 4-5 and 9. Harley-Davidson distributes the catalogs that feature its motorcycles, parts and accessories, and collateral goods to

Harley-Davidson dealerships and to motorcycle riders. Bolfert test. dep. p. 7; Paluso test. dep. p. 5.

In 1983, Harley-Davidson introduced a line of performance-enhancing motorcycle parts and accessories under the mark SCREAMIN' EAGLE. The mark was used on the motorcycle parts and accessories themselves and it appeared in product catalogs. Bolfert, test. dep. p. 30. In 1985 collateral goods bearing HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design appeared in the Harley-Davidson Fashion and Accessories catalog. Exhibit 28 to the Troll test. dep. Included in this catalog are belt buckles and pins with HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design as shown below.

The catalog page featuring the belt buckles is reproduced below. The belt buckles are items "K" and "L."



...UTH CYCLE CHAMP JACKET—The leather-look Cycle Champ for youths is a replica of our original adult Cycle Champ. The vinyl outer shell looks just like leather. Features snap-down lapels and collar action back and metal snaps and zippers. Includes belt.
98100-85VY Youth Sizes S(7-8), M(10-12), L(14-16), XL(18-20) $55.95

B. YOUTH ELITE—Lightweight unlined youth Elite jacket constructed of a tough oxford nylon. Features a mandarin collar, knit cuffs and waistband, and shoulder epaulets. Script Harley-Davidson embroidered on left front chest.
98135-84VY Sizes: Small (6-8), Medium (10-12), Large (14-16) Black $32.95

C. LADY-HARLEY™ ELITE JACKET—Lightweight jacket constructed of a tough antron nylon shell with 100% taffeta lining, combines fashion with function. Features a mandarin collar, knit cuffs and waistband, and shoulder epaulets. "Lady-Harley" embroidered above pocket. Sizes XXS, XS, S, M, L.
98130-84VW Tan $49.95
98131-84VW L. Blue $49.95

D. BLACK "ELITE" JACKET—Lightweight classic styled jacket constructed of a tough antron nylon shell with 100% taffeta lining. Features mandarin collar, knit cuffs and waistband, and shoulder epaulets with script "Harley-Davidson" embroidered above left pocket. Features inside accessory pocket. Sizes XXS, XS, S, M, L, XL.
98135-83V $49.95

A. RACE TEAM JACKET—Harley-Davidson's exclusive team jacket is available to racing fans. This lightweight nylon shell jacket is accented with black knit trim, orange and white sleeve stripes, and our prestigious race team logo embroidered on the left chest.
98140-82V Sizes XXS-XL $47.50

B. MAGNUM 1 NYLON JACKET combines performance with fashion. Constructed of DuPont Antron® nylon outer shell, full quilted lining, bellows standup collar with D-ring closure, knit cuffs and waistband. Sizes XS, S, M, L, XL. Available in gray or black
98126-84V Black $55.95
98127-84V Gray $55.95

C. BLACK/RED SATIN JACKET—Popular lightweight jacket of radiant satin and 4 ounce tricot-acetate polyfoam lining. Features embroidered logo on chest and an inside pocket. Sizes XXS, XS, S, M, L, XL
98137-82V $59.95

3. LIGHTWEIGHT JACKET—A stylish mid-weight jacket of unlined oxford nylon with mandarin collar, knit cuffs and waistband, and slash pockets. Black only with embroidered 1919 logo.
98133-85V $29.95

4. CORDURA®/THINSULATE JACKET—Warmth and durability are highlighted in a lightweight jacket combining a tough Cordura nylon outer shell with a warm Thinsulate lining that has a warmth factor exceeding that of goose down. Black with accenting gray sleeve stripes.
98136-86V Sizes S-XXL $89.95

5. RIDING JACKET—Constructed of 100% Antron nylon shell with 100% Hollofill polyester to protect you while riding. Includes a snap-down collar. Accented with piping on the sleeves and pockets. Features an embroidered Bar & Shield and embroidered Harley-Davidson on the back waistband. Available in sizes XS, S, M, L, XL, XXL.
98129-85V Brown $64.95
98125-85V Red $64.95
98128-85V Blue $64.95
98124-85V Burgundy $64.95
98138-85V Black $64.95

6 BIKER HATS—The popular biker hats in leather have embroidered "Harley-Davidson."
98C25-79V Black, Sizes S, M, L, XL $31.95
98C26-79V Brown, Sizes S, M, L, XL $31.95
FLYERS CAP—Black leather cap with embroidered logo on front, goggle snap on rear.
98C28-81V Sizes S, M, L, XL $41.95

7. MOTORCYCLE CAPS—Black polyester-cotton twill. Sizes 6⅞ to 7¾.
98610-77V With Black Visor $12.95
98C05-75V With White Visor $12.95

8. BASEBALL CAPS
A. 98388-84V Black w/Encircled Harley-Davidson ... $6.95
B. 98390-82V Black w/Eagle and "Scrambled Eggs" $8.50
C. 98387-84V Gray w/Encircled Harley-Davidson ... $6.95
D. 98384-82V Navy w/Made in USA Eagle $6.95

9. BASEBALL CAPS
A. 98380-82V Black Flattop w/Harley-Davidson $6.95
B. 98385-82V Black/Gray w/Winged H-D Patch $7.50
C. 98382-84V Black Cap w/Orange/White Script Harley-Davidson $6.95
D. 98381-84V Black Cap w/White Harley-Davidson $6.95

10. CHILD'S MOTORCYCLE CAP—Styled after the classic adult cap, this version sports an adjustable headband. Recommended for ages 6 & up. One size fits all.
98009-842 ..... $11.95

11. HARLEY-DAVIDSON BELTS—9 oz., top grain cowhide belts double embossed and hand stained and lacquered. Sizes S(28-30), M(33-34), L(36-38), XL(40-42), XXL(44-46).
A. 98456-82V Black, "Made in USA" w/basket weave design $14.95
B. 98457-82V Brown, "Made in USA" w/basket weave design $14.95
WOMEN'S BELT—New ½" ladies belt made of top grain oak tanned cowhide leather, double embossed, hand stained in brown & black. Sizes S, M, L.
C. 98455-84V Black $14.95
D. 98454-84V Brown $14.95
E. 98446-85V Winged Eagle, Black 1½" $14.95
F. 98447-85V Winged Eagle, Brown 1½" $14.95
G. 98458-82V Black, "Harley-Davidson" w/winged H-D top logos $14.95
H. 98453-84V Lady-Harley XS-L 1¼" $14.95

12. LIMITED EDITION BELT BUCKLE—Produced for Harley-Davidson by Brookfield Collectors Guild this buckle captures the spirit of the 100th anniversary of the Statue of Liberty. Included in this buckle are Mount Rushmore, the American Flag, Statue of Liberty, the first 1903 Harley-Davidson and the Bald Eagle. This hand sculptured and relieved buckle is a limited edition of 3,000.
98487-86V Available 10-15-85 ..... $24.95

13. BUCKLES
A. 98563-86V Eagle on American Shield $15.95
B. 98565-86V Eagle with "Made In USA" $15.95
C. 98486-85V Wings Up Eagle on Bar & Shield $15.95
D. 98484-82V Made in USA $16.95
E. 98465-82V Traditional Eagle $15.95
F. 98554-85V Winged H-D over Bar & Shield $15.95
G. 98552-85V Spread Eagle $15.95
H. 98561-86V H-D Crest $15.95
I. 98478-84V Lady-Harley $10.95
J. 98550-86V Fashion H-D $15.95
K. 98548-85V Screaming Eagle, Bronze $9.95
L. 98549-85V Screaming Eagle, Pewter $9.95
M. 9845 -84V Facing Team $16.95
N. 98464-85V Eagle Head on Black Leather $15.95
O. 98556-85V H-D on Oval $9.95
P. 98555-85V H-D on Rectangle $9.95

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The items are identified in the catalog as "Screamin' Eagle" pins and belt buckles. Pins and emblems appeared in the 1986 Harley-Davidson Fashion & Accessories catalog. Exhibit 10 to the Troll test. dep. Further, plaintiff introduced a copy of the Fall/Winter 1987-88 Harley-Davidson Fashion & Collectibles catalog in which an infant T-shirt, a baseball cap, a lighter, an emblem, and a knit cap appear. Each of the items bears HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design. Exhibit 12 to the Troll test. dep. These items are identified as "Screamin' Eagle" personal products.

From at least 1987 Harley Davidson promoted its collateral products bearing HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design through catalogs that were direct mailed to Harley-Davidson owners and sold the products at its Harley-Davidson dealerships. Bolfert test. dep. p. 7. From the mid-1980's through the 1990's these types of catalogs were distributed annually to over 400,000 households. Bolfert test. dep. p. 14. In this regard, plaintiff also introduced copies of Harley-Davidson catalogs for the years 1989, 1992, 1993, 1998, 1999, and 2000. Exhibit 4 to the Troll dep., Exhibit 9 to the T. Stratman disc. dep., Exhibits 20 and 42 to the Troll test. dep., Exhibit 10 to the R. Stratman disc. dep., and Exhibit 20 to the Troll test. dep. Among the items appearing in these

catalogs are infant T-shirts, sweatshirts, jackets, mugs, shot glasses, can coolers, baseball caps, lighters and emblems bearing HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design.

Tammy Stratman, president of Harley-Davidson's licensee R. K. Stratman, Inc., testified that her company began manufacturing "Screamin' Eagle brand [products] in 1987." T. Stratman disc. dep. p. 61. Her company primarily manufactures T-shirts bearing HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design which are shipped directly to Harley-Davidson dealers. T. Stratman disc. dep. p. 61. In 1987 R. K. Stratman, Inc. sold approximately $15 million dollars in Harley-Davidson products to dealers of which 8% was "Screamin' Eagle brand" merchandise. T. Stratman disc. dep. pp. 107-108. Sales of "Screamin' Eagle brand" merchandise has increased each year since 1987. T. Stratman disc. dep. pp. 105-106.

Global Products, another Harley-Davidson licensee, has manufactured mugs, shot glasses, ash trays, baseball caps, decals, t-shirts, polo shirts, sweatshirts and racing jackets bearing HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design since at least 1995. R. Stratman disc. dep. pp. 31-37. Global Products also sells its products to Harley-Davidson dealers. Although the precise sales figures were submitted under seal, the record shows

that since 1997 Global Products' sales of "Screamin' Eagle brand" merchandise has totaled tens of thousand of dollars. Exhibit 16 to R. Stratman disc. dep.

Sport Service is another Harley-Davidson licensee and it began selling "Screamin' Eagle brand" products in early 1999 to Harley-Davidson dealers and to individuals at National Hot Rod Association racing events. Woodruff test. dep. p. 18-19 and 22. Among the products manufactured by Sport Service are T-shirts, jackets, baseball caps, tank tops, long sleeve shirts and sweatshirts bearing HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design. Sport Service has sold approximately a half million dollars of "Screamin' Eagle brand" merchandise. Woodruff test. dep. pp. 18 and 35.

Applicant, Boutique, is a Canadian corporation which began doing business in Canada in the late 1970's. Berrada disc. dep. p. 86. Boutique is a wholesale company that deals in textiles, clothing, and leather accessories. Berrada disc. dep. p. 10. Boutique adopted the SCREAMING EAGLE name in Canada for retail services and clothing in 1985-86. Berrada test. dep. p. 125. Boutique has no retail stores in the United States that sell its products. It has not advertised in the United States and it does not promote its products over the Internet. Berrada disc. dep. p. 13. Its plans are to enter the U.S. market by having retail

outlets sell its products. Berrada disc. dep. pp. 18-19. It has not pursued those plans because of these proceedings. Berrada disc. dep. p. 104. Boutique's president, Mr. Berrada testified that he first learned of Harley-Davidson's use of SCREAMIN' EAGLE in 1990, 1992, or 1993 from Douglas Decent, marketing director of Fred Deely Imports, a Canadian distributor of Harley-Davidson products. Berrada disc. dep. pp. 60 and 66. Mr. Berrada was unable to recall if as of August 20, 1992, the filing date of Boutique's first application, he knew of Harley-Davidson's use of SCREAMIN' EAGLE. However, as of the filing dates of the subsequent applications (September 16, 1994 and April 18, 1995) he stated that he knew of Harley-Davidson's use of SCREAMIN' EAGLE, but only in connection with motorcycle parts. Berrada disc. dep. p. 73.

Plaintiff's burden of proof with respect to priority in the opposition and cancellation proceedings is a preponderance of the evidence. Eastman Kodak Co. v. Bell Howell Document Management Products Co., 994 F.2d 1569, 26 USPQ2d 1912, 1918 (Fed. Cir. 1993), citing 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Section 20.16 (3d ed. 1992). We find that plaintiff has met this burden in showing that it made prior common law use of the composite mark HARLEY-DAVIDSON SCREAMIN' EAGLE

PEFORMANCE PARTS and eagle design for pins, belt buckles, baseball caps, lighters and emblems/patches.[8]

Plaintiff's evidence of record establishes that Harley-Davidson offered pins and belt buckles as early as 1985 and baseball caps, lighters and emblems/patches as early as 1987 under this composite mark. Although Boutique contends that plaintiff's evidence fails in this regard because plaintiff offered no actual evidence of sales, i.e., sales invoices, there is no requirement that such evidence be submitted in order to establish prior use of a mark. Moreover, the evidence of record establishes that Harley-Davidson has made continuous use of the composite mark in connection with these and other kinds of collateral goods.

Even if, as Boutique has argued, Harley-Davidson's use of the composite mark on collateral goods served the purpose of promoting Harley-Davidson's motorcycle parts and accessories, Harley-Davidson is nonetheless entitled to rely on this use for purposes of priority. "We hasten to [note] that the mere fact that a collateral product serves the purpose of promoting a party's primary goods or services does not necessarily mean that the collateral product is not a good in trade, where it is readily recognizable as a

[8] We find that plaintiff has made prior common law use of the composite mark rather than SCREAMIN' EAGLE per se because of the manner in which SCREAMIN' EAGLE is used on the collateral goods, i.e., with HARLEY-DAVIDSON and PEFORMANCE PARTS and the eagle design.

product of its type (as would be the case with T-shirts, for example) and is sold or transported in commerce. See, for example: In re Snap-On Tools Corp., 159 USPQ 254 (TTAB 1968) [ball point pens which are used to promote applicant's tools, but which possess utilitarian function and purpose, and have been sold to applicant's franchised dealers and transported in commerce under mark, constitute goods in trade], and In re United Merchants & Manufacturers, Inc., 154 USPQ 625 (TTAB 1967)[calendar which is used as advertising device to promote applicant's plastic film, but which possesses, in and of itself a utilitarian function and purpose, and has been regularly distributed in commerce for several years, constitutes goods in trade]." Paramount Pictures Corp. v. White, 31 USPQ2d 1768, 1773 (TTAB 1994).

As previously noted, Boutique has argued that Harley-Davidson's use of the composite mark on the collateral goods was ornamental in nature and did not serve to create any trademark rights in the composite mark or SCREAMIN' EAGLE per se. Also, Boutique has argued that to the extent plaintiff/Harley-Davidson acquired trademark rights in the composite mark or SCREAMIN' EAGLE per se for collateral goods, those rights were abandoned as a result of non-use from 1994 to 1997. Plaintiff has objected to consideration of these issues, maintaining that they were not raised as affirmative defenses by Boutique in any amended pleading and

that there has been no trial of the issues. We find that Boutique's ornamental and abandonment defenses are untimely, and thus we decline to consider them. Boutique did not raise these defenses until its brief on the case. It failed to properly amend its answers to the opposition and the petitions to cancel after it learned of the facts which Boutique contends establish these defenses. Also, we agree with plaintiff that such issues were not tried by implied consent. To allow Boutique to raise the defenses at this late stage would be unfair surprise to plaintiff.

We should add that even if we were to consider Boutique's ornamental and abandonment defenses, we would find that they are without merit. Boutique has pointed to no evidence in the record that supports its contention that plaintiff's composite mark is perceived by the relevant purchasers as mere ornamentation.

Moreover, the fact that plaintiff did not introduce Harley-Davidson catalogs containing SCREAMIN' EAGLE merchandise for the period between 1994 and 1997 does not, as Boutique argues, establish that the composite mark was abandoned.

Likelihood of Confusion

In view of the fact that plaintiff has established its priority with respect to the composite mark HARLEY-DAVIDSON SCREAMIN'EAGLE PERFORMANCE PARTS and eagle design for

motorcycle parts and accessories as well as its collateral goods, namely belt buckles, baseball caps, pins, lighters, and patches/emblems, we turn to the issue of likelihood of confusion.

Our likelihood of confusion determination is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1975).

We turn first to the marks. Our consideration of the marks is based on whether each of Boutique's marks and plaintiff's mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who

normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The marks in Boutique's application and registrations are SCREAMIN' EAGLE and SCREAMING EAGLE. As previously indicated, plaintiff has established prior common law use of the composite mark HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design as shown below.

Applying the above principles to the marks at issue, it is clear that the distinctive term SCREAMIN' EAGLE is the dominant element in plaintiff's mark and the house mark HARLEY-DAVIDSON is displayed in a less prominent manner. Further, the phrase PERFORMANCE PARTS adds little impact to the overall commercial impression created by the plaintiff's

mark. With respect to the eagle design, it serves to reinforce the term SCREAMIN' EAGLE.

Considering the marks at issue in their entireties, we find that Boutique's marks SCREAMIN' EAGLE and SCREAMING EAGLE, in commercial impression, are highly similar to plaintiff's composite mark HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design.

We turn next to the issue of the similarity or dissimilarity of the parties' goods, trade channels, and class of purchasers. It is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See In re Martin's Famous Pasty Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The goods of Harley-Davidson and Boutique are identical with respect to belt buckles (class 26) and caps/baseball caps (class 25). Moreover, we find that Harley-Davidson's pins are closely related to the jewelry (class 14) identified in Boutique's pending application. Further, we find that Boutique's posters (class 16), coffee mugs (class 21) and wallets, handbags, etc. (class 18) are sufficiently related to Harley-Davidson's collateral goods as to be likely to cause confusion where as here the marks are highly similar and the record shows that Harley-Davidson has extensively licensed its composite mark on collateral goods. In other words, we find that Boutique's goods are within the natural zone of expansion for plaintiff's composite mark. See Mason Engineering & Designing Corp. v. Mateson Chemical Corp., 225 USPQ 956, 962 (TTAB 1985) [First user of a mark in connection with particular goods possesses superior rights "as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark"].

Boutique argues that its goods would be sold in different trade channels from the collateral goods of Harley-Davidson which are sold by way of Harley-Davidson catalogs, at Harley-Davidson dealerships, and trackside at National Hot Rod Association racing events. Further,

Boutique argues that Harley-Davidson's collateral goods are sold to sophisticated purchasers.

Indeed, the record shows that at the time of trial, Harley-Davidson's collateral goods offered under the composite mark HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design were sold only through the above limited channels of trade. However, the record also shows that Harley-Davidson brand collateral goods have been sold at retail outlets such as Bloomingdale's and Wal-Mart. Thus, it is not unreasonable to assume that Harley-Davidson may sell its HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design collateral goods at such retailers. We note that the goods listed in Boutique's application and registrations are not restricted in any way. Thus, we must assume that Boutique's goods would be sold in all customary channels of trade to all possible consumers for goods of their type. Canadian Imperial Bank of Commerce v. Wells Fargo, N.A., 811 F.2d 1460, 1 USPQ2d 1813 (Fed. Cir. 1987). Under the circumstances, it is quite possible that the HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design collateral goods and Boutique's goods may travel in some of the same channels of trade such as department stores and mass merchandisers. Also, although Harley-Davidson's collateral goods are sold primarily to owners of Harley-Davidson motorcycles, this is not an insignificant number of

persons and we may assume that these individuals would also be potential purchasers of Boutique's goods. In short, it may be presumed that there would be overlap in the purchasers.

As to Boutique's contention that the purchasers of Harley-Davidson's collateral goods are sophisticated purchasers, there is no evidence of record to support this contention. Moreover, considering that Harley-Davidson's collateral products are relatively inexpensive (e.g., a baseball cap is priced at $7.50 and an emblem at $1.95), it is unlikely that purchasers will exercise a great deal of care when purchasing these items.

In reaching our conclusion that confusion is likely, we have considered the evidence of third-party registrations and third-party uses of SCREAMIN/SCREAMING EAGLE submitted by Boutique. Boutique introduced copies of ten third-party registrations of marks consisting of SCREAMIN/SCREAMING EAGLE for various goods and services. In addition, Boutique introduced through the testimony of its witness, Ruth Dillon, Internet printouts showing use of "Screamin or Screaming Eagle." Boutique argues that this evidence shows that plaintiff's composite mark is diluted.

As often stated, third-party registrations generally are of limited probative value in determining the question of likelihood of confusion. This is so because they are not

evidence of use of the marks shown therein and they are not proof that consumers are so familiar with such marks so as to be accustomed to the existence of the marks in the marketplace. Richardson-Vicks, Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982).

As to the Internet printouts, we note that many of the uses of "Screamin or Screaming Eagle" therein are in connection with goods and services that are very different from plaintiff's collateral goods, e.g., high school and college mascots; wine; travel agency services; tree stands for hunting; and a United States military division. In short, this evidence does not establish that plaintiff's composite mark is weak or diluted.

In sum, having found that plaintiff's and Boutique's marks, when viewed in their entireties, are substantially similar in overall commercial impression and that plaintiff's collateral goods and the goods identified in Boutique's application and registrations are related, we conclude that the contemporaneous use of plaintiff's and Boutique's marks on their respective goods is likely to cause confusion as to source or sponsorship.

In view of our above likelihood of confusion finding, we need not reach the question of likelihood of confusion vis-à-vis Harley Davidson's motorcycle parts and accessories and the goods in Boutique's application and registrations.

Fraud

Plaintiff's fraud claim is based on its allegation that Boutique's averment in its involved application and the applications that matured into the involved registrations that no other person has the right to use the marks SCREAMING EAGLE and SCREAMIN' EAGLE in commerce constitutes a false material representation. Plaintiff maintains that Boutique's president, Mr. Berrada, knew of Harley-Davidson's prior rights in SCREAMIN' EAGLE for identical and related goods at the time Boutique filed each of the applications. In support of its position, plaintiff points to the testimony of Mr. Berrada that he knew of Harley-Davidson's use of SCREAMIN' EAGLE at least as early as "90, 92, 93". Berrada disc. dep. p. 66. Further, plaintiff points to Mr. Berrada's failed attempt to become a Harley-Davidson licensee in 1988; his possession of Harley-Davidson catalogs; his dealings with third-parties who manufactured collateral goods for Harley-Davidson, and his attendance at the same Canadian motorcycle trade show as Harley-Davidson.

Boutique, on the other hand, maintains that while Mr. Berrada learned of Harley-Davidson's use of SCREAMIN' EAGLE for motorcycle parts and accessories in the early 1990's, he had no knowledge of Harley-Davidson's use of SCREAMIN' EAGLE on clothing at the time it filed its applications. According to Boutique, its attempt to enter the U.S. market

was simply a natural progression for a brand that it had established in Canada five years earlier.

As previously indicated, Mr. Berrada testified that he first became aware of the use of SCREAMIN' EAGLE by Harley-Davidson in " '90, '92, '93." Berrada disc. dep. p. 66. In addition, Mr. Berrada, on behalf of Boutique, ordered merchandise from several third-parties in the United States who manufactured collateral goods for Harley-Davidson. Berrada, test. dep. pp. 23 and 30. Further, Mr. Berrada applied labels bearing Boutique's name and address and its SCREAMING EAGLE mark on Harley-Davidson catalogs that featured officially licensed products. Exhibits 7 and 8 to the Berrada deposition. According to Mr. Berrada, the catalogs "were sent to customers [in Canada] who deal in a variety of products, general merchandise…". Boutique was a "middleman" between U.S. distributors of Harley-Davidson merchandise and Canadian retailers. Berrada disc. dep. p. 42.

Douglas Decent, marketing director of Fred Deely Imports, a Canadian distributor of Harley-Davidson products, testified that he met Mr. Berrada in either late 1988 or early 1989 in Montreal. Mr. Berrada had applied for a silk screen license in Harley-Davidson's licensing program. According to Mr. Decent, when meeting with prospective licensees, he explains Harley-Davidson's business with

respect to motorcycle distribution, parts and clothing. He said he typically discusses brochures which cover Harley-Davidson's motorcycles, parts, accessories, fashions and collectibles. Further, Mr. Decent testified that he had seen Mr. Berrada at trade shows where Harley-Davidson brochures were displayed.

Our analysis of the fraud claim is governed by the following guidelines:

> Fraud implies some intentional deceitful practice or act designed to obtain something to which the person practicing such deceit would not otherwise be entitled. Specifically, it involves a willful withholding from the Patent and Trademark Office by an applicant or registrant of material information or fact, which, if disclosed to the Office, would have resulted in the disallowance of the registration sought or to be maintained. Intent to deceive must be "willful". If it can be shown that the statement was a "false misrepresentation" occasioned by an "honest" misunderstanding, inadvertence, negligent omission or the like rather than one made with a willful intent to deceive, fraud will not be found. Fraud, moreover, will not lie if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true or that the false statement is not material to the issuance or maintenance of the registration. It thus appears that the very nature of the charge of fraud requires that it be proven "to the hilt" with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.

First International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628, 1634 (TTAB 1988), citing Smith International Inc. v. Olin Corp., 209 USPQ 1033, 1043-44 (TTAB 1981).

We find that plaintiff has not met its "heavy burden of proof" in showing fraud. W.D. Byron & Sons, Inc. v. Stein Bros, Mfg. Co., 377 F.2d 1001, 153 USPQ 749 (CCPA 1967). In this case, the evidence points no clear picture that as of the filing dates of the applications, Mr. Berrada knew that Harley Davidson was using HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design on the identical goods as in Boutique's applications rather than on motorcycles parts and accessories. On cross-examination, Mr. Decent stated that he could not remember exactly what brochures he gave to Mr. Berrada. Thus, we do not know for certain that Mr. Decent gave Mr. Berrada brochures containing collateral products with HARLEY-DAVIDSON SCREAMIN' EAGLE PERFORMANCE PARTS and eagle design. Also, the brochures which Mr. Berrada had in his possession and on which he had placed Boutique's label did not contain collateral products bearing this composite mark.

Abandonment

With respect to the mark SCREAMIN' EAGLE in Boutique's Registration No. 2,188,686, plaintiff contends that there is no evidence of record of any use of this mark by Boutique since September 15, 1988, the date of issuance of the

registration. Thus, plaintiff argues that a prima facie case of abandonment has been established.

Boutique, on the other hand, argues that it has refrained from using this mark in the U.S. because of the cancellation proceeding. Further, Boutique contends that since the underlying application was based on an intent-to-use, it had 5-6 years from the filing date of the application to "show evidence that the mark is in use." Brief, p. 39.

A mark is deemed abandoned under Section 45 of the Trademark Act when its use has been discontinued with intent not to resume or commence use. Intent not to resume or commence use may be inferred from circumstances, and nonuse for three consecutive years constitutes prima facie evidence of abandonment. Section 45 of the Trademark Act.

A review of Boutique's underlying application reveals that it was not based on an intent-to-use. Rather, Boutique's Registration No. 2,188,686 issued under Section 44(e) of the Trademark Act. For a registration issued under Section 44(e), the statutory three-year period of nonuse that constitutes prima facie evidence of abandonment begins from the date of registration. See Imperial Tobacco, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990). Boutique has put forth no evidence of use of its mark since September 15, 1988, the date of issuance of Registration No. 2,188,686.

Thus, plaintiff has established a prima facie showing of abandonment. As to Boutique's contention that it refrained from using the mark because of the cancellation proceeding, the pendency of the cancellation proceeding is not in and of itself a special circumstance that excuses nonuse. This is unlike a forced withdrawal from the market due to outside causes such as import problems or unprofitable sales. See 1 J. T. McCarthy, *supra*, Section 17.04 (3d ed. 1992).

Decision: The opposition is sustained on the ground of likelihood confusion; the petitions to cancel are granted on the grounds of likelihood of confusion and abandonment.